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10/608,520	06/27/2003	Matthias Gerlach	103832-506-NP	8727
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EXAMINER				
WARD, PAUL V				
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/608,520
Filing Date: June 27, 2003
Appellant(s): GERLACH ET AL.

For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed March 19, 2009 and December 22, 2008 appealing from the Office action mailed November 25, 2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

The following are the related appeals, interferences, and judicial proceedings known to the Examiner, which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

(2) Related Appeals and Interferences

The statement of related appeals and interferences contained in the brief is correct.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct. However, examiner has withdrawn the rejection, under 35 U.S.C. 132(a) (new matter).

Thus, the only grounds of rejection are (a) 35 U.S.C. 112, 1st paragraph, rejection for claim 14, and (b) 35 U.S.C. 103 rejection for claims 1-11, 15-16 and 20, which are set forth below.

(7) Evidence Relied Upon

(a) Zhu et al. (WO 01/19798)

(8) Grounds of Rejection

The following grounds of rejection are applicable to the appealed claims:

A. 35 U.S.C. 112, 1st paragraph, rejection for claim 14.

Claim 14 fails to comply with the enablement requirement under 35 U.S.C. 112, first paragraph since the claim contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention without undue experimentation.

The claim is directed to a pharmaceutical composition or compositions comprising the claimed compounds. The claims are rejected for lack of enablement because there is an insufficient teaching of how to use the claimed compositions as claimed. The term "pharmaceutical composition" specifies that at least some

therapeutic benefit arise from some property of the composition. However, Applicant has not taught how to use the compounds of the invention to therapeutic effect for any condition.

Additionally, claim 14 is directed to a composition for use in the treatment of tumors. The term "tumors" is interpreted to include any and all forms of tumors/cancers. In light of this, it can be asserted that in spite of the vast expenditure of human and capital resources in recent years, no one drug has been found which is effective in treating all types of tumors/cancers because it is not a simple disease, nor is it even a single disease, but a complex of a multitude of different entities, each behaving in a different way.

Appellant's traversal is not persuasive. On page 11 of the Brief in the first full paragraph, Appellants submit that as long as the specification discloses at least one method for making and using the claimed invention that bears a reasonable correlation to the entire scope of the claim, then the enablement requirement is satisfied. However, Applicant's argument is inexact because the claim is rejected for lack of enablement since there is an insufficient teaching of how to use the claimed compositions as claimed. The term "pharmaceutical composition" specifies that at least some therapeutic benefit arise from some property of the composition. Intended use claims do not have patentability weight. A pill, for example, is a pill no matter what it is used for, and thus, intended use are not considered patentable. Thus, Applicant has not taught how to use the compounds of the invention to therapeutic effect for any condition. Therefore, claim 14 fails to comply with the enablement requirement.

B. 35 U.S.C. 103 rejection for claims 1-11, 15-16 and 20.

Claims 1-11, 15-16 and 20 were rejected under 35 U.S.C. 103(a) as being unpatentable over Zhu et al.

Applicant argues that the finding of obviousness is improper because the amended claims are a subgenus and has a different utility, and the fact that a claimed subgenus is encompassed by a prior art genus is not sufficient by itself to establish obviousness. Applicant's argument is misplaced, as the claim is rejected as a whole.

Zhu describes very similar subject matter to that claimed herein directed to amended claim 1, its compositions and uses. The analogs differ from Applicant claims in being substituted by naphthalene vs. instant phenyl or anthracene. (See formula 1, page 11 and definitions for A, Q, D, E, G, J and X). The claims differ from the reference by reciting specific species and a more limited genus than the reference. Thus it would have been obvious to one skilled in the art at the time the instant invention was made to modify the prior art compounds as discussed above in Zhu and in so doing obtain additional compounds for uses. One of ordinary skill in the art would have been motivated to select the claimed compounds from the genus in the reference since such compounds would have been suggested by the reference as a whole. A prior art disclosed genus of useful compounds is sufficient to render prima facie obvious a species falling within a genus.

Thus, instant claimed invention would have been obvious to one of ordinary skill in the art. Therefore, the rejection of the claims, under 35 USC § 103, were proper.

(9) Response to Argument

The response has been included with the rejection above.

(10) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the Examiner in the Related Appeals and Interferences section of this Examiner's Answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Paul V. Ward/

Patent Examiner, Art Unit 1624

Conferees:

/James O. Wilson/

Supervisory Patent Examiner, Art Unit 1624

/Joseph K. McKane/

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